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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			EXAMINER QUELER, ADAM M	
			ART UNIT 2179	PAPER NUMBER 16
DATE MAILED: 11/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,522

Applicant(s)

PARKER, PHILIP M.

Examiner

Adam M Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment B and RCE filed on 9/7/2004.
2. Claims 1-58 are pending in the case. Claims 1, 16, 29, 56-58, are independent claims.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/7/2004 has been entered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 for example recites, "providing an automation program." This program, while mentioned in the specification is never described. Therefore, one of ordinary skill in the art at the time of the invention would have no understanding of how to provide such a program.

Regarding dependent claim(s) 48, there is no indication in the specification of how material is created from content not contained within the program or database.

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The term "high level of complexity" in claim 55 is a relative term that renders the claim indefinite. The term "high level of complexity" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

9. The term "similar unique identification ... code" in claim 55 is a relative term that renders the claim indefinite. The term "similar unique identification ... code" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-2, 5-16, 20, 22-26, 28-29, 34-45, 45, 53-55, and 58, are rejected under 35 U.S.C. 102(b) as being anticipated by “Exploiting user models for personalizing news presentations” by Ardissono et al. (published 5/14/1999).**

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Regarding independent claim(s) 1 and 16, Ardissono discloses a module that is associated with a genre (p. 2, heading 3). Ardissono discloses authoring a title material (p. 2, heading 4) derived from a database file (p. 2, section 3, para. 3). Ardissono teaches that the authoring includes logical manipulation (sections 5 and 6). Ardissono discloses several attributes that describe the data, determined to be meta-data (p. 2, sec. 3, para. 2).

Regarding dependent claim(s) 29, Ardissono discloses a module that is associated with a genre (p. 2, heading 3). Ardissono discloses authoring a title material (p. 2, heading 4) derived from a database file (p. 2, section 3, para. 3). Ardissono teaches that the authoring includes logical manipulation (sections 5 and 6).

Regarding dependent claim(s) 2, Ardissono discloses the user requests the document from a server (p.2 sec. 2, para. 1). Therefore the authored document is distributed to the user.

Regarding dependent claim(s) 5 and 22, Ardissono discloses several attributes that describe the data, determined to be meta-data (p. 2, sec. 3, para. 2).

Regarding dependent claim(s) 6 and 23, Ardissono teaches conveying the data to the user, or distributing it (p. 2, sec. 3, para. 2, last line).

Regarding dependent claim(s) 7, 24, and 30, Ardissono teaches authoring marketing material (p. 2, sec. 3, para. 4).

Regarding dependent claim(s) 8 and 25, Ardissono discloses the user requests the document from a server (p.2 sec. 2, para. 1). Therefore the marketing material is distributed to the user.

Regarding dependent claim(s) 9-10, and 26, the specification defines control materials as including title and meta material, the distribution and authoring of which have been addressed in the rejection of claims 1-2 and 5-6 above.

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Regarding dependent claim(s) 11-13, it is the determination of the Office that anything inherently is capable of being associated with a number. Additionally, the number recited in claim 11 and incorporated into claims 12-13 is not positively recited by the claims.

Regarding dependent claim(s) 14, Ardissono teaches that the invention is done for each user (Abstract) therefore inherently there is a plurality of title material.

Regarding dependent claim(s) 15, Ardissono discloses the user requests the document from a server (p.2 sec. 2, para. 1).

Regarding dependent claim(s) 20, it is the determination of the Office that inherently any written document is capable of being associated with a number. Additionally, the authoring in one or more languages is not positively recited by the claims.

Regarding dependent claim(s) 28, Ardissono teaches a template used to author (section 7).

Regarding dependent claim(s) 34-45 and 53-54, the titles of the genres are found to be non-functional descriptive data and therefore taught by Ardissono.

Regarding dependent claim(s) 48, Ardissono teaches authoring marketing material (p. 2, sec. 3, para. 4), which is contained separately from the database file.

Regarding dependent claim(s) 55, Ardissono teaches a reasonably high level of complexity (whole document).

Regarding independent claim(s) 58, Ardissono discloses a module that is associated with a genre (p. 2, heading 3). Ardissono discloses authoring a title material (p. 2, heading 4) derived from a database file (p. 2, section 3, para. 3). Ardissono teaches that the authoring includes logical manipulation (sections 5 and 6). Ardissono discloses several attributes that describe the

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data, determined to be meta-data (p. 2, sec. 3, para. 2). Ardissono teaches that the document is a web page, which inherently has a URL, and alphanumeric code.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 3, 17-19, 27, 31-33, 46-49, 51-52, and 56, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ardissono.**

Regarding dependent claim(s) 3, 31, and 52 Ardissono does not explicitly disclose authoring in another language. However it would have been obvious to one of ordinary skill in the art to author in a desired language, as a specific language would tailor the document to the users cognitive characteristics (p. 3, bullet 2).

Regarding dependent claim(s) 17, Ardissono does not explicitly disclose a network of computers. Official Notice is taken that distributing over networked computers was well-known and desirable in the art at the time of the invention.

Regarding dependent claim(s) 18, Ardissono does not explicitly disclose a network of computers. Official Notice is taken the selling material over a network to an end user was well-known and desirable in the art at the time of the invention.

Regarding dependent claim(s) 19, Ardissono does not explicitly disclose a network of computers. Official Notice is taken the selling material over the Internet to an end user was well-known and desirable in the art at the time of the invention.

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Regarding independent claim(s) 27, Ardissono discloses several attributes that describe the data, determined to be meta-data (p. 2, sec. 3, para. 2). Ardissono teaches authoring marketing material (p. 2, sec. 3, para. 4). The specification defines control materials as including title and meta material, the distribution and authoring of which have been addressed above. Ardissono does not explicitly disclose a network of computers. Official Notice is taken the selling material over the Internet to an end user was well-known and desirable in the art at the time of the invention.

Regarding dependent claim(s) 32, Ardissono does not teach Windows or Linux. Official Notice is taken that compatibility with these programs was well-known and desired in the art at the time of the invention.

Regarding dependent claim(s) 33, Ardissono does not teach Visual Basic. Official Notice is taken that compatibility with these programs was well-known and desired in the art at the time of the invention.

Regarding dependent claim(s) 46, Ardissono does not teach a laptop or personal computer. Official Notice is taken that use of these was well-known and desired in the art at the time of the invention.

Regarding dependent claim(s) 47, Ardissono does not teach a microcomputer. Official Notice is taken that use of these was well-known and desired in the art at the time of the invention.

Regarding dependent claim(s) 49, Ardissono does not teach a PDF file. Official Notice is taken that use of these was well-known and desired in the art at the time of the invention.

Regarding dependent claim(s) 51, Ardissono does not teach a Word file. Official Notice is taken that use of these was well-known and desired in the art at the time of the invention.

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Regarding independent claim(s) 56, Ardissono discloses a module that is associated with a genre (p. 2, heading 3). Ardissono discloses authoring a title material (p. 2, heading 4) derived from a database file (p. 2, section 3, para. 3). Ardissono teaches that the authoring includes logical manipulation (sections 5 and 6). Ardissono discloses several attributes that describe the data, determined to be meta-data (p. 2, sec. 3, para. 2). Ardissono does not teach a PDF file. Official Notice is taken that use of these was well-known and desired in the art at the time of the invention.

14. Claims 4, 21, 50 and 57, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ardissono, and further in view of "Electric Portfolios," by Galloway.

Regarding dependent claim(s) 4 and 21, Ardissono does not explicitly disclose saving two versions. Galloway teaches saving in two formats (p. 5, para. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to use different formats so that the file is readable by people with different technologies (p. 5, para. 1).

15. Claims 50 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ardissono, and further in view of Applicant's Admitted Prior Art.

Regarding dependent claim(s) 50, Ardissono does not teach an ONIX. As the Applicant offers no enablement of what an ONIX file is, the Office determines it to be an admission that it was well-known in the art, at the time of the invention. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention to author in this format due to its known usage.

Regarding independent claim(s) 57, Ardissono discloses a module that is associated with a genre (p. 2, heading 3). Ardissono discloses authoring a title material (p. 2, heading 4) derived

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from a database file (p. 2, section 3, para. 3). Ardissono teaches that the authoring includes logical manipulation (sections 5 and 6). Ardissono discloses several attributes that describe the data, determined to be meta-data (p. 2, sec. 3, para. 2). Ardissono does not teach an ONIX. As the Applicant offers no enablement of what an ONIX file is, the Office determines it to be an admission that it was well-known in the art, at the time of the invention. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention to author in this format due to its known usage.

Response to Arguments

16. Applicant's arguments with respect to claims 1-58 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140.


The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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